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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,383	10/11/2001	Artur Fischer	1794	1289

7590

09/11/2003

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EXAMINER

GOFF II, JOHN L

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/11/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,383

Applicant(s)

FISCHER, ARTUR

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9, 11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9, 11 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to Amendment B filed on 7/14/03.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Newly submitted claim 13 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 13 is directed to a non-elected invention. Applicant elected the method claims in paper no. 9.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

4. Claims 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 8 requires the same limitations as claim 7.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. It is noted new claim 14 is cancelled claim 11 in independent form. However, new claim 14 with all of the limitations added together is confusing and needs clarification. Claim 14 appears to require a method for producing an adhesive bond comprising the steps of (1) providing a toy building block that consists of a solid foam that becomes adhesive by moistening; (2) applying starch which is dissolved in water to another element; (3) triturating the toy building block to form a pourable material; and (4) scattering the triturated material onto the other element. It is suggested to amend claim 14 with the above language so that the claim is not confusing as to what steps are preformed. This issue should be clarified and reworded as appropriate.

Claim Rejections - 35 USC § 103

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (Specification page 2) in view of Cho (U.S. Patent 5,813,895) and Dorfman (U.S. Patent 5,273,476).

The admitted prior art is directed to toy building blocks made from solid foam. The admitted prior art teaches the blocks are manufactured from an extruded and foamed starch material. The admitted prior teaches adhesively bonding one block to another block or to another element by moistening the block such that the block becomes adhesive, i.e. the adhesive properties of the starch are activated. The admitted prior art teaches the adhesive bond strength is low, especially in the case of adhesion of the block to another element made from a non-adhesive material (Specification page 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply an adhesive to one of the block, the other element, or both to increase the bond strength between the block and another element, and in particular, it would have been obvious to use a starch based adhesive (an adhesive closely related to the foam material) as it was well known in the art to bond two substrates using a starch based adhesive, i.e. starch in a liquid form, as shown for example by Cho and Dorfman to create an adhesive bond that is edible, i.e. not harmful if ingested by small children, and liquid-soluble, i.e. if desired the adhesive bond can be dissolved.

Cho is directed to a toy egg that simulates the hatching of an egg from an animal-like figure. Cho teaches the shell of the egg is formed of a plurality of pieces bonded together by an edible, liquid-soluble adhesive wherein the adhesive is made from starch (Column 1, lines 27-30

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and Column 2, lines 4-8). Dorfman is directed to a dissolvable toy package. Dorman teaches the package is made from two pieces joined together with a water-soluble binder wherein the binder is for example starch (Column 3, lines 67-68 and Column 4, lines 1-2).

10. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, Cho, and Dorfman as applied to claim 6 above, and further in view of Ross et al. (U.S. Patent 3,223,329)

The admitted prior art, Cho, and Dorfman teach all of the limitations in claims 7-9 as applied above except for a specific teaching of the starch based adhesive comprising starch in a water carrier and of applying the adhesive by spraying. One of ordinary skill in the art at the time the invention was made would have readily appreciated the starch based adhesive taught by the admitted prior art as modified by Cho and Dorfman as comprising starch in a water carrier as it was well known in the art to use water to activate the adhesive properties of starch as shown for example by Ross et al. Furthermore, it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to apply the starch based adhesive taught by the admitted prior art as modified by Cho and Dorfman by spraying as spraying was a well known technique in the art for applying an adhesive as shown for example by Ross et al. and only the expected results would be achieved.

Ross et al. are directed to an apparatus for applying an adhesive coated flock material. Ross et al. teach applying a flock coating to a substrate for purposes of decoration by spraying. Ross et al. teach the coating comprises flock material, an adhesive such as starch, and water. Ross et al. teach the water is present in the coating to activate the adhesive, i.e. starch (Column 2, lines 43-54).

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11. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Sullivan (U.S. Patent 4,534,511), Cho, and Dorfman.

The admitted prior art is directed to toy building blocks made from solid foam. The admitted prior art teaches the blocks are manufactured from an extruded and foamed starch material. The admitted prior teaches adhesively bonding one block to another block or to another element by moistening the block such that the block becomes adhesive, i.e. the adhesive properties of the starch are activated. The admitted prior art is silent as to triturating the solid foam into flock material. One of ordinary skill in the art at the time the invention was made would have readily appreciated triturating the solid foam taught by the admitted prior art to form a decorative flock material as it was well known in the art to do so as shown for example by the background of Sullivan to form a decorative (e.g. snow-like) material. The admitted prior art as modified by Sullivan is silent as to using an adhesive to bond the foam flocks to another element. However, it is noted the admitted prior art teaches the adhesive bond strength between the foam and another element is low (Specification page 2) such that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply an adhesive to one of the flock, the other element, or both to increase the bond strength between the flock and other element, and in particular, it would have been obvious to use a starch based adhesive (an adhesive closely related to the foam material) as it was well known in the art to bond two substrates using a starch based adhesive, i.e. starch in a liquid form, as shown for example by Cho and Dorfman to create an adhesive bond that is edible, i.e. not harmful if ingested by small children, and liquid-soluble, i.e. if desired the adhesive bond can be dissolved. Further, one of ordinary skill in the art at the time the invention was made would have readily appreciated

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applying the starch based adhesive to either the foam flocks or the other bonding element as only the expected results would be achieved, i.e. bonding the foam flocks to the other element.

Sullivan is directed to a flocking apparatus for spraying powdered flock onto a substrate for a decorative effect. The background of Sullivan teaches it is known to use foam flock as the flock material (Column 1, lines 25-29).

Response to Arguments

12. Applicant's arguments with respect to claims 6-9, 11, and 14 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues neither Cho nor Dorfman disclose parts which must be connected to one another by adhesion, of which at least one of the parts becomes adhesive by moistening. Also, none of the elements to be adhesively connected with one another is composed of a solid foam. It is noted the admitted prior art shows the well known technique of adhesively bonding one foam block to another foam block or to another element by moistening the block such that the block becomes adhesive. The admitted prior art further teaches the adhesive bond strength is low, especially in the case of adhesion of the block to another element made from a non-adhesive material. Cho and Dorfman are cited to show the well known technique of using a starch based adhesive to bond together two elements. One of ordinary skill in the art would have readily modified the admitted prior art to incorporate the starch based adhesive taught by Cho and Dorfman in view of the reasons given above in paragraph 9. Applicant further argues the adhesive connection taught by Cho and Dorfman is dissolved by water contact and the adhesive connection is not provided as in applicants invention. It is noted Cho and Dorfman teach an adhesive connection that is formed of starch

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and is water soluble, and it is not clear how this adhesive connection differs from applicants.

Applicant further argues the flocking in the patent to Sullivan is sprayed together with a binding agent, and not first the starch is applied in a liquid form and subsequently crushed foam is dispersed. As noted above in paragraph 11, one of ordinary skill in the art at the time the invention was made would have readily appreciated applying the starch based adhesive to either the foam flocks or the other bonding element as only the expected results would be achieved, i.e. in either application the foam flocks are bonded to the other element.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John L. Goff
September 10, 2003



Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700